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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,971	02/08/2005	Alexander Theil	265012US0PCT	1582
22850 7590 02/28/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SASTRI, SATYA B	
			ART UNIT 1713	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/28/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/28/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,971	<b>Applicant(s)</b> THEIL ET AL.	
	<b>Examiner</b> Satya B. Sastri	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                    |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                               | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/8/05, 10/11/05, 12/6/05</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This office action is in response to application filed on February 8, 2007. Claims 1-6, 8 are now pending in the application.

#### ***Claim Objection***

2. Claim 1 is objected because it is unclear if the composition comprises a copolymer of methyl methacrylate or a homopolymer (PMMA) with no additional comonomer. Up to 4% comonomer with MMA would not afford a PMMA as recited in the claim language.

The spelling of moulding in claim 1 may be corrected to "molding".

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a material comprising a thermoplastic and an impact modifier and further alludes to the material as comprising PMMA molding composition. It is unclear if the thermoplastic is PMMA.

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rostami (WO 00/29480).

At the outset, it is noted that WO 00/29480 is used for date purposes. US 6,689,832 B1 is used as the English language equivalent of WO 00/29480 and is used in the body of the rejection.

Rostami discloses methacrylate molding composition comprising 20-89% wt. of an acrylic polymer containing 50-99% by wt. of methyl methacrylate units and 1-50% by wt. of a copolymerizable alkyl acrylate (abstract, col. 2, lines 6-15). The acrylic copolymer has a molecular wt. between 60,000 and 180,000 (col. 2, lines 28-35). The mixture may also contain other additives, such as stabilizers, toughening agents etc. Suitable toughening agents include rubbers, present in amounts of 1-50%, more preferably, from 3-25% by wt. (col. 2, lines 58-65). The shaped article may be formed by melt molding methods such as extrusion and injection

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molding (col. 3., lines 1-27). The prior art also discloses that acrylic sheet materials are particularly useful for forming bathtubs, architectural cladding, shower enclosures, paneling etc. (col. 1, lines 8-15).

The instant claims read on prior art molding compositions and sheets that comprise 96-99% methyl methacrylate units and 1-3% by wt. of a copolymerizable alkyl acrylate. Additionally, given that the prior art molding compositions may be extruded as recited in instant claims, it must inherently result in a semifinished product with resistance to hot water. Thus, instant claims are anticipated by the prior art.

In the alternative, it would have been obvious to a skilled artisan that the properties would be present once the Rostami product is provided because materials and their properties are inseparable. It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al.*, 205 USPQ 594, 596 (CCPA 1980).

### ***Conclusion***

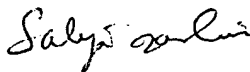
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 272 1112.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 272 1114.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SATYA SASTRI

February 21, 2007



DAVID W. WU  
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